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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/920,592	07/31/2001	Brian Bodmer	LS/0023.00	5999

7590

12/27/2005

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EXAMINER

SHAH, AMEE A

ART UNIT

PAPER NUMBER

3625

DATE MAILED: 12/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/920,592

Applicant(s)

BODMER ET AL.

Examiner

Amea A. Shah

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 July 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-57 is/are pending in the application.
- 4a) Of the above claim(s) 20-57 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 July 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 10 Nov. 2003
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claims 1-57 are pending in this application.

Response to Amendment

Applicant's amendment, filed July 14, 2005, is acknowledged and entered. Claims 1, 30 and 42 have been amended. Claims 20-29 have been withdrawn. Claims 54-57 have been added.

Election/Restrictions

Applicant's election of Group I, including claims 1-19, in the reply filed on July 14, 2005, is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Groups II and III, claims 20-57, are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on July 14, 2005 (as discussed above).

Amended claims 30 and 42 include limitations of fulfilling the order which were classified in Group III and are therefore still with non-elected Group III. Newly added claims 54-57 also contain the limitations of fulfilling the order, and are considered a part of non-elected Group III. Therefore, only Group I, claims 1-19, are examined in this action

Examiner Note

Examiner cites particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that, in preparing responses, the applicant fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Specification

The use of numerous trademarks, such as KODAK, K-MART, WALGREENS, RITE-AID, MICROSOFT and AMAZON.COM, has been noted in this application. The use of trademarks should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

Claim Rejections - 35 U.S.C. § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 10 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 10 recites the limitation "the request for images" in line 1 of the claim. There is insufficient antecedent basis for this limitation in the claim. For purposes of this action only, the examiner will interpret claim 10 to be a dependency of claim 9, and not claim 1.

Claim Rejections - 35 U.S.C. § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4, 7, 8, 11, 13 and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Garfinkle et al., U.S. Patent No. 6,017,157 (hereinafter referred to as “Garfinkle et al.”).

Referring to claim 1. Garfinkle et al. discloses a method for an e-commerce retailer to display and sell items of a third party comprising:

- identifying one or more items of a third party with a unique identifier (Fig. 4 and col. 4, lines 6-20 – note the unique identifier is the access code, the item is a digital image and the third party is the photographer);
- associating the unique identifier of the item with an image of the item, said image residing on a computer maintained by a third party (Fig. 4 and col. 4, lines 6-23 – “the digital

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images and associated information are stored in a single directory on a local machine of the photographer or at the scanning center...”);

- presenting at least some of the images to a user for on-line commerce (Fig. 5 and col. 4, line 57 through col. 5, line 29), said images being retrieved from said computer maintained by a third party (col. 4, lines 24-33 and 57-67 – note the retrieval of images is using the upload interface to transfer data);
- in response to an order request from the user for one or more items, identifying, based at least in part on said unique identifier, each item requested and an appropriate third party for each requested item (Figs. 1 and 5E, and col. 5, lines 19-29, col. 7, lines 16-42 and col. 9, lines 8-41); and
- automatically generating an order for each requested item (Fig. 5E and col. 9, lines 14-25).

Referring to claim 2. Garfinkle et al. further discloses the method of claim 1, wherein the items include products (col. 5, lines 23-29 – note the products are prints, and merchandise).

Referring to claim 3. Garfinkle et al. further discloses the method of claim 1, wherein the items include services (col. 5, lines 19-23 – note the services are emailing and downloading images).

Referring to claim 4. Garfinkle et al. further discloses the method of claim 1, wherein the images of items include graphic images (col. 5, lines 16-19 – note the images are thumbnails).

Referring to claim 7. Garfinkle et al. further discloses the method of claim 1, wherein a given unique identifier references pricing information from a third party (col. 8, line 38 through col. 9, line 13).

Referring to claim 8. Garfinkle et al. further discloses the method of claim 1, wherein a given unique identifier references order fulfillment information (col. 4, lines 60-66 and col. 9, lines 8-32).

Referring to claim 11. Garfinkle et al. further discloses the method of claim 1, wherein a particular third party provides photo-finishing services and the images correspond to user photographic images (*see* Abstract).

Referring to claim 13. Garfinkle et al. further discloses the method of claim 1, wherein a given third party initially provides smaller thumbnail images of the items and provides larger images in response to user requests (col. 7, lines 4-15).

Referring to claim 16. Garfinkle et al. further discloses the method of claim 1, wherein the images are rendered on a Web page for display to the user (col. 6, line 56 through col. 7, line 15 – note the Web page is the HTML page)

Claim Rejections - 35 U.S.C. § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5, 9, 10, 12 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Garfinkle et al. in view of Baum, Pat. App. Pub. No. US 2002/0065741 A1 (hereinafter referred to as “Baum”).

Referring to claim 5. Garfinkle et al. discloses the method of claim 1, as discussed above, but does not disclose wherein the images of items include descriptive text. Baum, in the same field of endeavor of e-shopping, discloses a method for distributing images to multiple recipients including wherein the images of items include descriptive text (Baum, Fig. 5 and page 8, ¶0080 – note the descriptive text is the number for the images).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to have modified the system of Garfinkle et al. to include the teachings of Baum to allow for the images of the items to include descriptive text. Doing so would allow a user to better comprehend and identify the image.

Referring to claim 9. Garfinkle et al. discloses the method of claim 1, as discussed above, but does not disclose wherein said step of presenting includes: requesting images from a third party; receiving a list of Uniform Resource Locators (URLs) for said requested images; and displaying an on-line page that displays images retrieved from said URLs. Baum, in the same

field of endeavor of e-shopping, discloses a method for distributing images to multiple recipients including wherein the step of presenting includes: requesting images from a third party; receiving a list of URLs for said requested images; and displaying an on-line page that displays images retrieved from said URLs (Baum, Fig. 9 and pages 7-8, ¶¶0075 and 0080).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to have modified the system of Garfinkle et al. to include the teachings of Baum to allow for the step of presenting to include: requesting images from a third party, receiving a list of URLs for said requested images, and displaying an on-line page that displays images retrieved from said URLs. Doing so would allow users to have access to view various images being considered for purchase or re-order from another source, as suggested by Baum (page 7, ¶0075).

Referring to claim 10. Garfinkle et al. in view of Baum discloses the method of claim 9 including wherein the request for images includes background and formatting information of a particular third party (Baum, page 7, ¶¶0072 and 0075), so that users can consider alterations to the images that may better suit their purposes, as suggested by Baum (page 7, ¶0072).

Referring to claim 12. Garfinkle et al. discloses the method of claim 1, as discussed above, but does not disclose wherein a given third party provides Uniform Resource Locators (URLs) for images in various sizes and formats, thereby enabling retrieval and display of images to the user in various sizes and formats. Baum, in the same field of endeavor of e-shopping, discloses a method for distributing images to multiple recipients including wherein a given third party provides URLs for images in various sizes and formats, thereby enabling retrieval and

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display of images to the user in various sizes and formats (Baum, Figs. 5 and 9, and page 8, ¶0080).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to have modified the system of Garfinkle et al. to include the teachings of Baum to allow for a given third party to provide URLs for images in various sizes and formats, thereby enabling retrieval and display of images to the user in various sizes and formats. Doing so would allow users to have access to view images in various manners to better determine which image to order, as suggested by Baum (page 7, ¶¶0072 and 0075).

Referring to claim 17. Garfinkle et al. discloses the method of claim 1, as discussed above, but does not disclose wherein the unique identifier of an item requested by the user is employed for placing a fulfillment request with a corresponding third party. Baum, in the same field of endeavor of e-shopping, discloses a method for distributing images to multiple recipients including wherein the unique identifier of an item requested by the user is employed for placing a fulfillment request with a corresponding third party (Baum, page 7, ¶0075 – note the unique identifier is the number used to reorder).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to have modified the system of Garfinkle et al. to include the teachings of Baum to allow for the unique identifier of an item requested by the user to be employed for placing a fulfillment request with a corresponding third party. Doing so would provide for a more seamless and accurate ordering system, as suggested by Baum (page 7, ¶0075).

Claims 6 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Garfinkle et al. in view of Lyons et al. Pat. App. Pub. No. US 2002/0077937 A1 (hereinafter referred to as "Lyons et al.").

Referring to claim 6. Garfinkle et al. discloses the method of claim 1, as discussed above, but does not disclose wherein a given unique identifier references a corresponding product Stock Keeping Unit (SKU) numbers. Lyons et al., in the same field of endeavor of e-shopping, discloses a method for ensuring availability of inventory for electronic commerce, including wherein a given unique identifier references a corresponding product SKU numbers (Lyons et al., page 3, ¶0026).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to have modified the system of Garfinkle et al. to include the teachings of Lyons et al. to allow for a given unique identifier to reference a corresponding product SKU number. Doing so would allow the seller to know exactly in which product the buyer is interested and can provide information accordingly, as suggested by Lyons et al. (page 3, ¶0026).

Referring to claim 14. Garfinkle et al. discloses the method of claim 1, as discussed above, but does not disclose wherein a given third party evaluates the request for images or descriptions and automatically indicates whether corresponding items are available. Lyons et al., in the same field of endeavor of e-shopping, discloses a method for ensuring availability of inventory for electronic commerce, including wherein a given third party evaluates the request for images or descriptions and automatically indicates whether corresponding items are available (Lyons et al., page 5, ¶¶0045-0046).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to have modified the system of Garfinkle et al. to include the teachings of Lyons et al. to allow for a given third party to evaluate the request for images or descriptions and automatically indicate whether corresponding items are available. Doing so would provide buyers with confirmation that the desired items are actually available and aid them in the purchase decision, as suggested by Lyons et al. (page 1, ¶0005).

Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Garfinkle et al. in view of Shmueli et al. Pat. App. Pub. No. US 2002/0143637 A1 (hereinafter referred to as "Shmueli et al.").

Referring to claim 15. Garfinkle et al. discloses the method of claim 1, as discussed above, but does not disclose wherein the unique identifier associated with a given item is stored in a user's shopping cart when the user selects the item. Shmueli et al., in the same field of endeavor of e-shopping, discloses a portable shopping cart wherein the unique identifier associated with a given item is stored in a user's shopping cart when the user selects the item (Shmueli et al., page 6, ¶0066).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to have modified the system of Garfinkle et al. to include the teachings of Shmueli et al. to allow for the unique identifier associated with a given item to be stored in a user's shopping cart when the user selects the item. Doing so would provide for a more seamless and efficient transaction in ensuring that the item desired can be held in a virtual shopping cart before the buyer must make a final determination whether or not to buy the item.

Claims 18 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Garfinkle et al. in view of Johnson et al., U.S. Pat. No. 6,505,172 B1 (hereinafter referred to as “Johnson et al.”).

Referring to claims 18-19. Garfinkle et al. discloses the method of claim 1, as discussed above, but does not disclose the method further comprising automatically splitting an order including individual order items from more than one third party, and assigning fulfillment of individual order items to the appropriate third parties (claim 18), nor splitting order including items from the retailer and items from one or more third parties amongst the retailer and the appropriate third parties (claim 19). Johnson et al., in the same field of endeavor of e-shopping, discloses a method for electronic sourcing of items including automatically splitting an order including individual order items from more than one third party, and assigning fulfillment of individual order items to the appropriate third parties, and splitting an order including items from the retailer and items from one or more third parties amongst the retailer and the appropriate third parties (Johnson et al., col. 15, line 39 through col. 16, line 15).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to have modified the system of Garfinkle et al. to include the teachings of Johnson et al. to allow automatically splitting an order including individual order items from more than one third party, and assigning fulfillment of individual order items to the appropriate third parties, and splitting an order including items from the retailer and items from one or more third parties amongst the retailer and the appropriate third parties. Doing so would allow buyers to purchase from multiple vendors at one session, as suggested by Johnson et al. (col. 2, lines 8-22).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

1) Fredlund et al., U.S. Pat. No. 5,666,215, discloses a method for remotely selecting photographic images for printing, reprinting and ordering (*see, e.g., cols. 4-8*).

2) Stromberg, Pat. App. Pub. No. US 2002/0007322 A1, discloses a method for providing supplemental product-specific information without interfering with the commercial transaction at the point of sale (*see, e.g., pages 2-8*).

3) McIntyre et al., Pat. App. Pub. No. 2005/0114232 A1, discloses a method for providing image goods and/or services to more than one party located at different locations (*see, e.g., pages 2-4*).

4) Amazon.com, archived Dec. 19, 2000, available at www.archive.org, discloses a website selling third party merchandise.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amee A. Shah whose telephone number is 571-272-8116. The examiner can normally be reached on Mon.-Fri. 7:00 am - 3:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn W. Coggins can be reached on 571-272-7159. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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AAS

December 20, 2005

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